

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

| | | |
|------------|--|-------------------------|
| Applicants | : Shuji SHIKANO et al. | Group Art Unit : 2622 |
| Appl. No. | : 10/597,250 (U.S. National Stage of PCT/JP2005/001326) | Examiner : T. Ho |
| I.A. Filed | : January 31, 2005 | Confirmation No. : 8324 |
| For | : IMAGE PICKUP APPARATUS, IMAGE PICKUP LENS, AND DATA WRITING METHOD TO IMAGE PICKUP LENS | |

RESPONSE TO ELECTION REQUIREMENT WITH TRAVERSE

Commissioner for Patents
U.S. Patent and Trademark Office
Customer Service Window, Mail Stop AMENDMENT
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

In response to the Examiner's Election Requirement dated February 4, 2010, setting forth a one-month period for response to expire March 8, 2010, Applicants elect, with traverse, the Species 2, corresponding to figure 2 and claims 7-9, with traverse. Claims 7-9 are considered to be readable on the invention of Species 2, corresponding to figure 2.

Initially, Applicants would like to express their appreciation to the Examiner, Mr. Tuan Ho, for the courtesy of the telephone interview conducted with their attorney Ms. Linda J. Hodge, on February 15, 2010. During the interview, Applicants' attorney pointed out that in the Response to Restriction Requirement and Election Requirement With Traverse filed on November 10, 2009, Species 2 (figure 2) was already elected (in addition to Group I); and that, accordingly, the

outstanding Election Requirement was unnecessary. Nevertheless, the Examiner requested that Applicants respond to the outstanding election requirement. Accordingly, Applicants have herewith elected Species 2 (corresponding to figure 2), thus fully responding to the outstanding election requirement.

Additionally, Applicants respectfully traverse the Election Requirement. Although the Examiner has couched the requirement for election as lacking “unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1”, the Examiner has failed to follow the procedure set forth in MPEP § 1893.03(d) by (a) listing “the different groups of claims” and (2) explaining “why each group lacks unity with each other group (*i.e.*, why there is no single inventive concept) specifically describing the unique special technical feature in each group”. The Examiner has recognized that the present application is a national stage (filed under 35 U.S.C. § 371) application and has made the requirement purportedly under PCT Rule 13.1, but has not, in fact, established a lack of unity of invention of the claims of the present application. As stated in MPEP § 1893.03(d), “[a] group of inventions is considered to form a single general inventive concept where there is a technical relationship among the inventions that involves at least one common or corresponding special technical feature”.

Applicants submit that claims 1-9 of the present application define only a single inventive concept, that is, of providing image pickup including determining and manipulating optical magnification data. The “inventions” identified by the Examiner, *i.e.*, in Species 1 and 2, are disclosed as different elements of this inventive concept. However, they are still part of the single general inventive concept of providing image pickup including determining and manipulating optical magnification data. While the Examiner has identified a plurality of “inventive concepts” descriptive

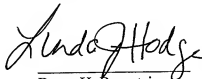
of the embodiments of the invention, the question is not whether the embodiments of the invention differ, but rather whether the embodiments share common features. Thus, since it is clear that there is only a single inventive concept defined in claims 1-9, the Examiner is respectfully requested to withdraw the requirement for lack of unity of invention.

Additionally, it would appear that the search for the groups identified by the Examiner would be coextensive or at least significantly overlap. That is, if the Examiner were to perform a search for the embodiment of Species 2, there would not appear to be a serious burden in continuing the examination of the other embodiments, especially since all of the claims are directed to providing image pickup including determining and manipulating optical magnification data.

For the foregoing reasons, it is submitted that the Election Requirement (requirement for lack of unity of invention) in this application is improper and it is respectfully requested that the requirement be reconsidered and withdrawn.

Should the Examiner have any questions, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,
Shuji SHIRANO et al.



Linda J. Hodges
Reg. #47,363

Bruce H. Bernstein
Reg. No. 29,027

March 4, 2010
GREENBLUM & BERNSTEIN, P.L.C.
1950 Roland Clarke Place
Reston, Virginia 20191
(703) 716-1191